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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,032	11/18/2003	Alan Strasbaugh	212/521	7327
23371	7590	06/14/2005	EXAMINER	
CROCKETT & CROCKETT 24012 CALLE DE LA PLATA SUITE 400 LAGUNA HILLS, CA 92653			ELEY, TIMOTHY V	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/717,032

Applicant(s)

STRASBAUGH ET AL.

Examiner

Timothy V. Eley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-11 is/are rejected.
- 7) ☒ Claim(s) 2,4 and 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,3, and 5-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3,4-6, and 10 of U.S. Patent No. 6,866,564. Although the conflicting claims are not identical, they are not patentably distinct from each other because to clean and dry the wafer after backgrinding would have been obvious to one having ordinary skill in the art at the time the invention was made since clearly the wafer needs to be cleaned to remove any debris generated during backgrinding.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kataoka et al (6,273,791).

- Kataoka et al disclose a method of preparing a wafer, the method comprising the steps of; providing a wafer having a front side and a backside; building-up a device onto the front side of the wafer; providing a chuck and a tape, wherein the chuck is suitable for supporting the tape during a backgrinding process, and wherein the tape is suitable for supporting the wafer; after building up the device, placing the tape onto the chuck; placing the front side of the wafer onto the tape; securing the front side of the wafer to the tape; grinding the backside of the wafer; and removing the wafer from the tape. See column 4, lines 7-23. Note, since applicant has not

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provided any specific order of steps, the tape can be placed on the wafer and then on the chuck.

- Kataoka et al does not specifically disclose a step of processing the wafer such that the wafer has a flatness and a thickness suitable for building-up the device on the front side of the wafer, nor drying the wafer after washing.
- However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a wafer suitable for building-up a device on the front side of the wafer, and to dry the wafer after cleaning(washing) in order to remove any stray wash fluid.
- Regarding claim 10, applicant's broad recitation of "resilient" is met by Kataoka et al, since virtually any tape is "resilient".

6. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brouillette et al(6,153,536).

- Brouillette et al discloses a method of preparing a wafer, the method comprising the steps of; providing a wafer having a front side and a backside; building-up a device onto the front side of the wafer; providing a chuck and a tape, wherein the chuck is suitable for supporting the tape during a backgrinding process, and wherein the tape is suitable for supporting the wafer; after building up the device, placing the tape onto the chuck; placing the front side of the wafer onto the tape; securing the front side of the wafer to the tape; grinding the backside of the wafer; and removing the wafer from the tape. See 2, lines 16-26, lines 34-48, lines 56-65; column 3, lines 43-63; and column 4, lines 11-15. Note, since applicant has not

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provided any specific order of steps, the tape can be placed on the wafer and then on the chuck.

- Brouillette et al does not specifically disclose a step of processing the wafer such that the wafer has a flatness and a thickness suitable for building-up the device on the front side of the wafer, nor drying the wafer after washing.
- However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a wafer suitable for building-up a device on the front side of the wafer, and to dry the wafer after cleaning(washing) in order to remove any stray wash fluid.
- Regarding claim 10, applicant's broad recitation of "resilient" is met by Brouillette et al, since virtually any tape is "resilient".

Allowable Subject Matter

7. Claims 2,4, and 12 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- The cited references disclose wafer manufacturing.

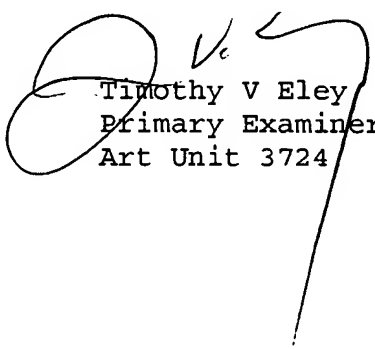
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy V. Eley whose

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telephone number is 571-272-4506. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Timothy V Eley
Primary Examiner
Art Unit 3724

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